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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,827	04/15/2004	Claude Ray		7739

7590
Kenneth L. Tolar
808 N. Causeway Blvd.
Metairie, LA 70001

05/25/2005

EXAMINER

REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,827

Applicant(s)

RAY ET AL.

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Election 4/14/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

[1] Claim 6 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely did not traverse the restriction (election) requirement in the reply filed on 4/14/2005; so therefore, the election is treated as an election without traverse.

The requirement is still deemed proper and is therefore made FINAL.

Consequently, claims 1-10 are pending.

Drawings

[2] The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. To preface, the following statements are not found in the elected diagrams (3-6) as indicated by the applicant. Therefore, the “casing having an outer edge with an indentation thereon...” (it appears as if the structure of 15 from Figs. 1-2 is different than that proposed in Figures 4 and 6) as well as, “a switch hingedly secured at a first end to said housing, said switch carrying a battery thereon...” must be shown in the elected figures or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

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even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

[3] The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[4] Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Due to the claimed subject matter from the instant claim not matching up correctly

with the elected figures or disclosed properly in the specification, the information therefore fails to be definite (see section regarding diagrams above).

[5] Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Beginning with line 3 in Claim 10, "said bezel receiving said neck and including a circumferential slot positioned beneath said lip;" indicates that there is a slot positioned beneath said lip, when the slot is truly at the bottom of the bezel. Overall, the claim does not properly address/recite both the structural and functional relationship between the bezel, lip, slot, and clip when in use and thus is considered indefinite.

Claim Rejections - 35 USC § 102

[6] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[7] Claims 1-3 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Albanese, US-4,764,850, because the invention was patented or described in a printed publication in this or a

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foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Albanese is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Albanese teaches of a jewelry item with a rotating gemstone comprising:
a substantially hollow housing (22) having an upper end (25) and a lower end (24);
a bezel (42) rotatably mounted on the upper end of said housing (via 18);
a gemstone (20) mounted on said bezel (42);
a motor means (30) received within said housing (22) [for automatically rotating said bezel and said gemstone at a predetermined, discrete speed]

Examiner's note: the statement within brackets is an example of intended use, as the statement does not further limit the structure of the claimed invention. It only requires that the prior art have the capacity of performing such, and in the instant case, it does.

Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re : Claim 2, further comprising a gear assembly (32, 33) including a plurality of gears (32, 33) driven by said motor means (30) and operably connected to said bezel (42), said gears (32, 33) having a predetermined, precise gear ratio [for rotating said bezel at a discrete speed].

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Re: Claim 3, wherein said discrete speed is between 2 and 4 revolutions per minute (from column 3, line 12, “gearing to a range of 2 rmps to 3 rpms”).

[8] Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Marshall, US- 6,209,242, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

The shape and appearance of Marshall is identical in all material respects to that of the claimed design, *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456, 43 USPQ2d 1887 (Fed. Cir. 1997).

As for Claim 1, Marshall teaches of a jewelry item with a rotating gemstone comprising:
a substantially hollow housing (14) having an upper end (top of 14) and a lower end (bottom of 14);

a bezel (72) rotatably mounted on the upper end of said housing (via 24);

a gemstone (from column 3, line 58, “This invention allows for different display attachments to be used on the main base of the display.” Also, from Column 6, line 46, “A kit may be provided to a retailer having holders for holding various jewelry or other items...”)
mounted on said bezel (72);

a motor means (14) received within said housing (14) [for automatically rotating said bezel and said gemstone at a predetermined, discrete speed]

Examiner’s note: the statement within brackets is an example of intended use, as the statement does not further limit the structure of the claimed invention. It only requires that the prior art have the capacity of performing such, and in the instant case, it does.

Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*.

Re: Claim 4, wherein said motor means (14) is a quartz movement motor (from column 1, line 12, "...supplied by a quartz motor").

Re: Claim 5, wherein said quartz movement motor includes a casing (14) having an outer edge with an indentation thereon (opposite of 14), said indentation substantially aligned with an opening on an outer wall of said housing, said indentation having at least one electrical contact therein (inside 14), said electrical contact electrically connected to said motor (inside 14);

a switch hingedly (27) secured at a first end to said housing (14), said switch (27) carrying a battery (18) thereon, said switch (27) having a free end which is pivotal towards and away from said housing (14) to selectively position said battery (18) against said contact.

Claim Rejections - 35 USC § 103

[9] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[10] Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albanese, US-4,764,850, in view of Hartman, US-5,971,829, and further in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 7, Albanese teaches of the above claims 1-3 and of a drive gear (32) connected to said means (30); and a bezel gear (33) connected to said bezel (42) and engaging said sprocket (18).

The difference between the claim and Albanese is the claim recites: a lower spacer plate superimposed on said driver gear, said spacer plate having an aperture with said drive gear received therein; and an intermediate gear engaging said drive gear, said intermediate gear having an upper surface with a sprocket extending therefrom; Hartman discloses a motorized device similar to that of Albanese. In addition, Hartman further teaches of a lower spacer plate (21b) superimposed on said driver gear (24), said spacer plate (21b) having an aperture (36b) with said drive gear received therein; and an intermediate gear (28b) engaging said drive gear (28a), said intermediate gear (28b) having an upper surface with a sprocket extending therefrom (26). It would have been obvious to one of ordinary skill in the art, having the disclosures of Albanese and Hartman before him at the time the invention was made, to modify the gear structure of Albanese to incorporate an intermediate gear as in Hartman. One would have been motivated to make such a combination because having such a number of gears in such a orientation allows for a reducing gear set that regulates the revolution output properly and as stated by Hartman from column 3, 56, "produce a proper torque to turn..."

Re: Claim 8, wherein said lower spacer plate includes a depression thereon that receives said intermediate gear (It would have been an obvious matter of art recognized equivalence to create a depression or another hole for the intermediate gear to be positioned in/on, as the pertinence behind the intermediate gear is its position between both the drive gear and bezel gear as to properly provide the movement upwards; Applicant has also not disclosed that it solves any stated problem of the prior art or is for any particular purpose. It appears that the invention would perform equally well as the invention disclosed by Albanese in view of Hartman.

Re: Claim 9, further comprising an upper spacer plate (21a) superimposed on said lower spacer plate (21b) with said intermediate gear (28b) positioned therebetween.

Allowable Subject Matter

[11] Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

As for Claim 10, the prior art, incorporating other corresponding limitations as set forth above, does not teach of the structural/functional relationship between the bezel, the slot at the bottom of the bezel, the lip and neck; whereby when the bezel is overtop the shroud (lip and neck) the two pieces are held together by a clip that passes through the slot of the bezel and attaches to the neck of the shroud.

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Conclusion

[12] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited further to show the state of the art with respect to this particular type of jewelry item; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: please see submitted notice of reference cited.

[13] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ROBERT J. SANDY
PRIMARY EXAMINER

Sincerely,
David Reese
Examiner
Art Unit 3677